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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,357	12/19/2005	Toshitaka Araga	WAKAB50.002APC	9655
20995 7590 02/21/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER CHOI, PETER Y	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 02/21/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,357	<b>Applicant(s)</b> ARAGA ET AL.	
	<b>Examiner</b> PETER Y. CHOI	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/12/07 and 01/18/08</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## FINAL ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Regarding claims 4-6, claim 4 recites “a surface layer... formed in the needle punched non-woven body.” Applicants’ specification does not provide for multiple surface layers, as claim 1 now recites a surface layer.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-6, it is unclear what structure is claimed in claim 1 by the limitation “the felt layer is layered *under* the thermoplastic resin sheet” (emphasis added). A recitation of “under” is indefinite since “under” refers to a spatial relationship which is subjective and unclear based on the structure set forth in the claim.

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Regarding claims 4-6, claim 4 recites “a surface layer...formed in the needle punched non-woven body.” It is unclear whether the surface layer claimed in claim 4 is another surface layer or is referring to the surface layer set forth in claim 1.

Regarding claims 7-13, claim 7 recites that the surface layer is formed on “an upper surface of the elastic non-woven body.” It is unclear what structure is claimed in claim 7 by the limitation reciting the surface layer formed on “an *upper* surface of the elastic non-woven body” (emphasis added). A recitation of “upper” is indefinite since “upper” refers to a spatial relationship which is subjective and unclear based on the structure set forth in the claim. Additionally, claim 7 recites that the “thermoplastic resin being thinner than the elastic non-woven body.” It is unclear how the thermoplastic resin itself (a layer is not specifically mentioned) can be claimed as thinner than the non-woven body.

### ***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 are rejected under 35 U.S.C. 102(a) or 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Pub. No. 2003/0203687 to Akuzawa.

Regarding claims 1-6, Akuzawa teaches a formed mat which is thermoformed so as to have a shape following an inside of a room of an automobile and is fitted so as to follow the inside of the room, the formed mat comprises a felt layer, a thermoplastic resin sheet, a non-woven body which is 3.0 mm or more in thickness,  $300 \text{ g/m}^2$  or more in weight per unit area, and less than  $0.20 \text{ g/cm}^3$  in density, and a wear resistance surface layer integrally formed on a surface of the elastic non-woven body, wherein the non-woven body is layered on the thermoplastic resin sheet so that the wear resistance surface layer directs to the inside of the room of the automobile, and the felt layer is layered under the thermoplastic resin sheet (see entire document including paragraphs 0002, 0008-0019, 0030-0037, 0040-0053, 0065-0067, 0072-0074). It should be noted that for purposes of examination, since the surface layer is integrally formed on a surface of the non-woven body, the surface layer and the non-woven body are considered as one structure.

Regarding claims 1-6, Akuzawa does not appear to specifically teach that the non-woven body is elastic. However, Akuzawa appears to teach a non-woven body which is substantially similar in structure and composition (non-woven body comprising polyester fibers and low-melting polyester fibers with the claimed weight percentages, fiber length and fiber diameter) as the claimed non-woven body and as described in Applicants' specification. Therefore, the

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claimed elasticity appears to be inherent to the fibers comprising the non-woven body.

Properties are the same when the structure and composition are the same. The burden is on the Applicants to prove otherwise.

Regarding claims 2-5, the elastic non-woven body is a needle punched non-woven body which has polyester fibers of 50-99% by weight and polyester-based low melting point fibers of 1 to 50% by weight, the polyester fibers having a fiber diameter of 3 to 15 dtx and a length of 40 to 120 mm, and the polyester-based low melting point fibers having a fiber diameter of 3 to 12 dtx and a length of 40 to 90 mm (paragraphs 0031-0036, 0040-0046).

Regarding claim 3, the needle punched non-woven body contains, as the polyester fibers, two or more types of fibers having different fiber diameters (paragraphs 0031-0036, 0040-0046).

Regarding claim 4, a surface layer having wear resistance is formed in the needle punched non-woven body (paragraphs 0043-0050).

Regarding claim 5, Akuzawa does not appear to specifically teach that the fibers constituting the surface layer having wear resistance have a color tone different from that of fibers constituting other portions of the needle punched non-woven body, and a decorative pattern is formed by partially taking out the fibers constituting the other portions of the needle punched non-woven body onto a surface of the surface layer having wear resistance. However, since Akuzawa teaches that a dope-dyeing fiber may be used as fibers forming the fiber sheet to improve a design property and that a gradient structure is contemplated (paragraphs 0041, 0046-0049). Since the surface material of Akuzawa may comprise various fibers including binder fibers, and since various fibers inherently have different color tones, the claimed limitation appears to be inherent to the structure of the fibers of Akuzawa. Additionally, it would have

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been obvious to one of ordinary skill in the interior material art at the time the invention was made to form the invention of Akuzawa and varying the fibers, as Akuzawa suggests various fibers suitable for the invention of Akuzawa and choosing a known commercially available material as suggested by the reference to improve a design property is within the ordinary level of skill in the art.

Akuzawa appears to teach a substantially similar structure and composition as the claimed invention, including providing for a decorative design (for example, paragraph 0041). Additionally, the limitation requiring that a decorative pattern is formed by partially taking out the fibers constituting the other portions of the needle punched non-woven body onto a surface of the surface layer having wear resistance appears to be a product by process limitation. Absent a showing to the contrary, it is Examiner's position that the article of the applied prior art (a thermoformed mat comprising an elastic non-woven body with the claimed structure and specifications) is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The burden has been shifted to Applicants to show unobvious difference between the claimed product and the prior art product. The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if Applicants intend to rely on Examples in the specification or in a submitted declaration to show unobviousness, Applicants should clearly state how the Examples of the present invention are commensurate in scope with

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the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Regarding claim 6, Akuzawa does not appear to specifically teach that the recovery percentage in a folding test is 70% or more, wherein the recovery percentage denotes a ratio of an open angle around a folding line at a time when the formed mat is supported at the folding line and is left alone after the formed mat is folded over by 180 degrees around a straight line so as to face portions of the thermoplastic resin sheet each other, to an original 180 degrees, since the Akuzawa invention does not appear to be subjected to such a test. Although the prior art does not disclose the recovery percentage property, the claimed property is deemed to be inherent to the structure in the prior art since the Akuzawa reference teaches an invention with a substantially similar structure and chemical composition (a thermoformed mat comprising an elastic non-woven body with the claimed structure and specifications) as the claimed invention. Properties are the same when the structure and composition are the same. The burden is on the Applicants to prove otherwise.

Regarding claims 7-13, Akuzawa teaches a formed mat thermoformed in a shape configured to be fitted inside a room of an automobile, comprising a felt layer, a non-woven body for sound absorption having a thickness of 3.0 mm or more, a weight of 300 g/m<sup>2</sup> or more, and a density of less than 0.20 g/cm<sup>3</sup>, a wear resistance surface layer integrally formed on an upper surface of the nonwoven body, and a thermoplastic resin sheet for sound isolation which is formed between the non-woven body and the felt layer, the thermoplastic resin being thinner than the high elastic non-woven body (see entire document including paragraphs 0002, 0008-0019, 0030-0037, 0040-0053, 0065-0067, 0072-0074). It should be noted that for purposes of



examination, since the surface layer is integrally formed on a surface of the non-woven body, the surface layer and the non-woven body are considered as one structure.

Regarding claims 7-13, Akuzawa does not appear to specifically teach that the non-woven body is elastic. However, Akuzawa appears to teach a non-woven body which is substantially similar in structure and composition (non-woven body comprising polyester fibers and low-melting polyester fibers with the claimed weight percentages, fiber length and fiber diameter) as the claimed non-woven body and as described in Applicants' specification. Therefore, the claimed elasticity appears to be inherent to the fibers comprising the non-woven body. Properties are the same when the structure and composition are the same. The burden is on the Applicants to prove otherwise.

Regarding claims 8-11, the elastic non-woven body is needle punched and comprises 50-99% by weight of polyester fibers having a fiber diameter of 3 to 15 dtx and a length of 40 to 120 mm and 1 to 50% by weight of polyester-based low melting point fibers having a fiber diameter of 3 to 12 dtx and a length of 40 to 90 mm (paragraphs 0031-0036, 0040-0046).

Regarding claim 9, the non-woven body contains, as the regular polyester fibers, two or more types of fibers having different fiber diameters (paragraphs 0031-0036, 0040-0046).

Regarding claim 10, the non-woven body further comprises a surface layer having wear resistance (paragraphs 0002, 0008-0019, 0030-0037, 0040-0053, 0065-0067, 0072-0074).

Regarding claim 11, Akuzawa does not appear to specifically teach that the fibers constituting the surface layer having wear resistance have a color tone different from that of fibers constituting other portions of the non-woven body, and a decorative pattern is formed by partially taking out the fibers constituting the other portions of the non-woven body onto the

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surface of the surface layer having wear resistance. However, since Akuzawa teaches that a dope-dyeing fiber may be used as fibers forming the fiber sheet to improve a design property and that a gradient structure is contemplated (paragraphs 0041, 0046-0049). Since the surface material of Akuzawa may comprise various fibers including binder fibers, and since various fibers inherently have different color tones, the claimed limitation appears to be inherent to the structure of the fibers of Akuzawa. Additionally, it would have been obvious to one of ordinary skill in the interior material art at the time the invention was made to form the invention of Akuzawa and varying the fibers, as Akuzawa suggests various fibers suitable for the invention of Akuzawa and choosing a known commercially available material as suggested by the reference to improve a design property is within the ordinary level of skill in the art.

Akuzawa appears to teach a substantially similar structure and composition as the claimed invention, including providing for a decorative design (for example, paragraph 0041). Additionally, the limitation requiring that a decorative pattern is formed by partially taking out the fibers constituting the other portions of the needle punched non-woven body onto a surface of the surface layer having wear resistance appears to be a product by process limitation. Absent a showing to the contrary, it is Examiner's position that the article of the applied prior art ((a thermoformed mat comprising an elastic non-woven body with the claimed structure and specifications) is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

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Regarding claim 12, the mat further comprises a felt layer layered underneath the thermoplastic resin sheet (paragraphs 0002, 0008-0019, 0030-0037, 0040-0053, 0065-0067, 0072-0074).

Regarding claim 13, Akuzawa does not appear to specifically teach that the mat has a recovery percentage of 70% or more as measured by a folding test wherein a test piece of the formed mat is bent on a folding line until portions of the thermoplastic resin sheet touch each other, and an angle  $\alpha$  formed at the folding line between the portions of the thermoplastic resin sheet is measured after releasing the bent test piece, wherein the recover percentage is expressed as  $\alpha / 180^\circ \times 100$ , since the Akuzawa invention does not appear to be subjected to such a test. Although the prior art does not disclose the recovery percentage property, the claimed property is deemed to be inherent to the structure in the prior art since the Akuzawa reference teaches an invention with a substantially similar structure and chemical composition (a thermoformed mat comprising an elastic non-woven body with the claimed structure and specifications) as the claimed invention. Properties are the same when the structure and composition are the same. The burden is on the Applicants to prove otherwise.

In the event it is shown that Akuzawa does not disclose the claimed invention with sufficient specificity, the invention is obvious because Akuzawa discloses the claimed constituents and discloses that they may be used in combination.

### ***Claim Rejections - 35 USC § 103***

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as obvious over Akuzawa in view of USPN 5,677,027 to Masuda.

Regarding claims 1-13, in the event it is shown that Akuzawa does not appear to teach an elastic non-woven body, Masuda teaches that it was known in the automobile insulating material art to form a substantially similar structure and composition as Akuzawa, wherein the cushioning layer is a non-woven body comprising first fibers and bonding fibers, the first fibers and bonding fibers comprising substantially similar compositions and weight percentages as those disclosed in Akuzawa, wherein the bonding fibers comprise elastic copolyester (Masuda, column 1 lines 5-11, column 2 lines 33-62, column 3 lines 16-45, column 4 line 22 to column 6 line 67). Masuda teaches various advantages due to the inclusion of elastic copolyester fibers such as superior damping effect, improved sound transmission loss, superior sound insulation and adequate cushioning effect. Similarly, Akuzawa teaches that an object of the invention of Akuzawa is to provide an automobile surface material with excellent sound absorption property (*see* Akuzawa, paragraph 0010). It would have been obvious to one of ordinary skill in the automobile insulating material art at the time the invention was made to form the automobile insulating material of Akuzawa, wherein the bonding fibers comprise elastic copolyester, as taught by Masuda, motivated by the desire of forming a conventional automobile insulating material having a superior damping effect, improved sound transmission loss, superior sound insulation and adequate cushioning effect due to the inclusion of elastic copolyester, and the combination of the elastic copolyester fibers and polyester fibers in a nonwoven fabric was known in the automobile insulating material art and the results predictable from such a combination.

Regarding claims 1-13, although Akuzawa in view of Masuda does not appear to teach the claimed recovery percentages, the claimed recovery percentages are deemed to be inherent to

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the prior art combination since the prior art combination teaches a substantially similar structure and composition as the claimed invention, absent evidence to the contrary.

### ***Response to Arguments***

8. Applicants' arguments with respect to claims 1-13 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

9. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER Y. CHOI whose telephone number is (571)272-6730.

The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/  
Primary Examiner, Art Unit 1794

/Peter Y. Choi/  
Examiner, Art Unit 1794  
February 13, 2008